

REMARKS

I. Status of Claims

In the present Amendment, claim 1 has been amended, claims 3-7 have been withdrawn from consideration as being directed to non-elected subject matter, and new claim 8 has been added. Specifically, claim 1 has been amended to further define the product of the equation in proviso (2). Support for this amendment can be found in the specification at page 5, lines 14-15. New claim 8 is directed to a steel forging having the composition of claim 1. Support for this amendment can be found in the original specification. *See, for example,* the last paragraph on page 6, and the first paragraph on page 10. Therefore, Applicants have not introduced any new matter by the amendment, nor does the amendment raise new issues or necessitate the undertaking of any additional search of the art by the Office.

Claims 1, 2 and 8 are subject to examination in this application.

II. Specification

Pursuant to the Examiner's request, Applicants have provided herewith a new abstract on a separate sheet of paper. Thus, Applicants request that this objection be withdrawn.

III. Response to Rejection under 35 U.S.C. §103

The Examiner has rejected claims 1 and 2 under 35 U.S.C. §103 asserting that the claims are obvious in view of JP 07-157824 ("JP 824"). The Examiner further asserts that, while the exact ranges set out in claim 1 are not disclosed on the cited

reference, the ranges disclosed overlap the claimed ranges and render them *prima facie* obvious.

The Examiner's rejection is respectfully traversed for at least the following reasons.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Internat'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007).

Thus, in order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner must first show that the prior art references teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The Examiner must also show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The Supreme Court, in the recent *KSR* case, recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). See

KSR Internat'l Co. v. Teleflex Inc., 82 U.S.P.Q.2d 1385 (U.S. 2007). In addition, the Supreme Court mandated that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

Following the KSR decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that "**in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.**" (Emphasis in original).

As noted by the Examiner, "the ranges taught by JP '824 are not identical to the claimed ranges." Office Action at 4. According to the Examiner, however, "the overlap is sufficient to establish a *prima facie* case of obviousness." *Id.* Applicants respectfully disagree for at least the following reasons.

Even if JP '824 discloses overlapping ranges, as asserted by the Examiner, it clearly does not meet the three provisos of claim 1. In fact, neither JP '824 nor the Examiner ever address these provisos. Therefore, this reference clearly is deficient in that it does not teach or suggest all of the claimed limitations.

In addition, contrary to the Office's established procedures, the Examiner has not identified one reason why a person of ordinary skill in the art would have combined the

prior art elements in the manner claimed. In fact, Applicants submit that the particular composition cited on page 4 of the Office Action makes it clear that the Examiner could not have modified this composition to arrive at the claimed invention because this particular composition teaches away from the claimed proviso. For example, the amount of V and N would clearly violate proviso (1) of claim 1, e.g., wt% V x wt% N = 0.0021 to 0.0120. As discussed in MPEP 2144.05, "Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing . . . that the art, **in any material respect**, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)(emphasis added).

Similarly, nothing, other than Applicants' disclosure, would have suggested the claimed provisos. The Federal Circuit has repeatedly warned that the requisite motivation must come from the prior art, not applicant's specification. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-1532 (Fed. Cir. 1988) ("[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure."). Using an applicant's disclosure as a blueprint to reconstruct the claimed invention from isolated pieces of the prior art contravenes the statutory mandate of section 103 of judging obviousness at the point in time when the invention was made. See *Grain Processing Corp. v. American Maize-Prod. Co.*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988).

In view of the complete lack of teaching or suggestion in the cited references, alone or in combination, one can objectively conclude that the Examiner has improperly reconstructed the claimed invention by using Applicants' disclosure. Applicants, therefore, respectfully request withdrawal of the rejection based on the above reference.

Furthermore, JP '824 is **silent** with respect to the claimed provisos does not serve as the "clear and particular" motivation necessary to establish a *prima facie* case of obviousness. *See In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (explaining that the motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved but must still be supported by actual evidence that is "clear and particular").

For at least the foregoing reasons, Applicants submit that the § 103(a) rejection of claims 1 and 2 is improper, and should be withdrawn.

IV. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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